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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,485	10/30/2003	Edward J. Stashluk JR.	067439.0138	7404

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EXAMINER

RHODE JR, ROBERT E

ART UNIT PAPER NUMBER

3625

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,485	STASHLUK ET AL.	
	Examiner	Art Unit	
	Rob Rhode	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 20 are drawn to method, performed by a returns provider, of
handling customer returns of items on behalf of multiple merchants
including notifying the merchant of a return package, based on the results
of the correlating step, classified in class 705, subclass 26.
- II. Claim 21 are drawn to a method, performed by a returns provider, of handling
customer returns of items on behalf of multiple merchants including
notifying the returnee of a return package, based on the results of the
correlating step, classified in class 705, subclass 27.
- III. Claims 22 - 26 are drawn to a system for handling customer returns of items
on behalf of multiple merchants, the returns being made by customers in
packages having machine readable labels and for transmitting return rules
for display at one or more of the return centers and wherein the return
rules specify at least a procedure for return notifications, classified in 705,
subclass 26.
- IV. Claims 27 - 32 are drawn to a method, performed by a returns provider, of
handling customer returns of items on behalf of multiple merchants
including handling the package return in response to the correlating step,
classified in class 705, subclass 26.

Inventions Groups I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group II has separate utility such as a method, performed by a returns provider, of handling customer returns of items on behalf of multiple merchants including notifying the returnee of a return package, based on the results of the correlating step. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Inventions Groups I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group III has separate utility such as a system for handling customer returns of items on behalf of multiple merchants, the returns being made by customers in packages having machine readable labels and for transmitting return rules for display at one or more of the return centers and wherein the return rules specify at least a procedure for return notifications. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Inventions Groups I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group IV has separate utility such as a method, performed by a returns provider, of handling customer returns of items on behalf of multiple merchants including handling the package return in response to the correlating step. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Inventions Groups II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group III has separate utility such as a system for handling customer returns of items on behalf of multiple merchants, the returns being made by customers in packages having machine readable labels and for transmitting return rules for display at one or more of the return

centers and wherein the return rules specify at least a procedure for return notifications. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Inventions Groups II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group IV has separate utility such as a method, performed by a returns provider, of handling customer returns of items on behalf of multiple merchants including handling the package return in response to the correlating step. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Inventions Groups III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group IV has separate utility such as a method, performed by a returns provider, of handling customer returns of items on behalf of multiple merchants including handling the package return in response to the correlating step. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Species

In the event the applicant elects Group I above, the applicant is further obligated to elect among the following species as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention:

- Ia. Species of claims 1 - 6 the method wherein the method is performed.
- Ib. Species of claims 1 and 7 the method wherein the machine readable label further has data representing the package origin and package delivery location.

lc. Species of claims 1 and 8 - 10 the method further comprising the step of notifying the customer.

ld. Species of claims 1 and 11 - 13 the method further comprising the step of using the machine readable data.

le. Species of claims 1 and 14 the method further comprising the step of using the processing system.

lf. Species of claims 1 and 15 the method further comprising the step opening the package.

lg. Species of claims 1 and 16 the method further comprising the step of transmitting data from the scanning step.

lh. Species of claims 1 and 17 - 20 the method further comprising the step of transmitting data about the return.

In the event the applicant elects Group III above, the applicant is further obligated to elect among the following species as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention:

IIIa. Species of claims 22 and 23, the system wherein the processing system is further operable to communicate return information to the merchant

IIIb. Species of claims 22 and 24, the system wherein the processing system is further operable to communicate return information to the customer.

IIlc. Species of claims 22 and 25, the system wherein the processing system is further operable to access shipping charges for the package.

IIId. Species of claims 22 and 25, the system further comprising an opening station.

In the event the applicant elects Group IV above, the applicant is further obligated to elect among the following species as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention:

Va. Species of claims 27, 28 and 32, wherein the handling step is performed by notifying the merchant.

Vb. Species of claims 27, 29 and 32, wherein the handling step is performed by notifying the customer.

Vc. Species of claims 27, 30 and 32, wherein the handling step is performed by disposing of the package.

Vd. Species of claims 27, and 31 - 32, further comprising the step of opening the package to extract the return item.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently for Group I, Claim 1 is generic, Group II, Claim 21, Group III, claim 22 is generic and for Group IV, Claim 27 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Rob Pond** can be reached on **571.272.6760**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including
After Final communications labeled
"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RER

A handwritten signature in black ink, appearing to read "RER" followed by a stylized flourish.